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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/735,363	12/12/2000	Nigel C. Phillips	02811-0181	3925

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EXAMINER

ZARA, JANE J

ART UNIT PAPER NUMBER

1635

14

DATE MAILED: 06/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

File

Office Action Summary

Application No.

09/735,363

Applicant(s)

Phillips et al

Examiner

Jane Zara

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for ReplyA SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Mar 17, 2003
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5, 7, 8, 10-20, 22-28, and 42-45 is/are pending in the application.
- 4a) Of the above, claim(s) 11-20, 22-28, and 42-45 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7, 8, and 10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 6 6) ☐ Other:

File

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DETAILED ACTION

This Office action is in response to the communication filed March 17, 2003, Paper No.

15.

Claims 1-5, 7, 8, 10-20, 22-28, 42-45 are pending in the instant application.

Election/Restriction

This application contains claims 11-20, 22-28, 42-45 drawn to an invention nonelected with traverse in Paper No. 13. A complete reply to the final rejection must include cancelation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Any rejections not repeated in this Office action are hereby withdrawn.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Response to Arguments and Amendments

Maintained Rejections

Claims 1-6 and 10 are rejected under 35 U.S.C. 112, first paragraph, for lacking adequate written description, for the reasons of record set forth in the Office action mailed December 17, 2002, Paper No. 14.

Applicant's arguments filed March 17, 2003 have been fully considered but they are not persuasive. Applicants argue that distinguishing features have been adequately described for the

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members of the claimed genus encompassed by the formulae of claim 1. Contrary to Applicants' assertions, the generic formulae encompass a broad array of potential sequences (e.g. thousands of sequences), and a representative number of species encompassing this expansive genus has not been adequately described with specific guidance in the instant disclosure. The species indicated in the specification represent a small subset of the broad genus, and this subset is not adequate to describe the genus claimed.

Applicants argue that the ability of the multiple GT-containing sequences listed in tables 2-4 (pages 16-18 of the specification) to inhibit cell proliferation in vitro also provides an adequate number of species identifying the members of the broad genus claimed. Contrary to Applicants' assertions, this subset of sequences represented within the broad generic formulae listed in claim 1 do not provide adequate description of the vary large number of sequences embodied by these formulae, and the in vitro inhibition of target cell growth does not compensate for the lack adequate description (e.g. lack of representative species for the broad genus).

Claims 1-3, 5, 7, 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Frank et al for the reasons of record set forth in the Office action mailed December 17, 2002, Paper No. 14.

Applicant's arguments filed March 17, 2003 have been fully considered but they are not persuasive. Applicants argue that the prior art cited does not teach the claimed invention because SEQ ID NO: 45 consists of a hexanucleotide and Frank et al teach a larger oligonucleotide sequence comprising the hexanucleotide of SEQ ID No: 45. Contrary to Applicants' assertions,

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the claimed invention is drawn to compositions which comprise oligonucleotide sequences between 2-20 (or optionally between 2-7 bases) of the generic formulae claimed and including SEQ ID NO: 45. The claims do not read on hexanucleotides, but instead read on compositions comprising at least this hexanucleotide. Therefore, Frank et al has been cited appropriately as prior art encompassing oligonucleotides comprising at least 2-20 nucleobases, and not limited to hexanucleotides.

Conclusion

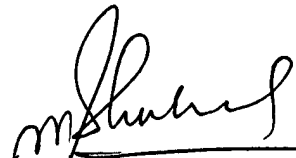
THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Certain papers related to this application may be submitted to Art Unit 1635 by facsimile transmission. The faxing of such papers must conform with the notices published in the Official Gazette, 1156 OG 61 (November 16, 1993) and 1157 OG 94 (December 28, 1993) (see 37 C.F.R. § 1.6(d)). The official fax telephone numbers for the Group are (703) 308-4242 and (703) 305-3014. NOTE: If Applicant *does* submit a paper by fax, the original signed copy should be retained by applicant or applicant's representative. NO DUPLICATE COPIES SHOULD BE SUBMITTED so as to avoid the processing of duplicate papers in the Office.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Jane Zara** whose telephone number is (703) 306-5820. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John LeGuyader, can be reached on (703) 308-0447. Any inquiry regarding this application should be directed to the patent analyst, Katrina Turner, whose telephone number is (703) 305-3413. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.


RAM SHUKLA
PRIMARY EXAMINER

JZ

May 27, 2003